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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,855	12/03/2003	Mary Jane Kelly	12194/3	5620

7590 07/14/2004

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EXAMINER

LEGESSE, NINI F

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/726,855	Applicant(s) KELLY, MARY JANE	
	Examiner Nini F. Legesse	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/31/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hulsman (US Patent No. 3,227,455) in view of Cutting (US Patent No. 2,928,678).

- **With respect to claims 1, 9 and 11**, Hulsman discloses a golf club grip (12) comprising: a body portion (14) having a hollow interior portion adapted to be secured to a shaft of the sporting element (column 1, lines 47-48 indicate a golf club); a fingers receiving member (18) connected to the body portion, whereby the user could secure a hand to the shaft of the sporting element (see Fig. 5). Hulsman also discloses wherein a generally flexible body portion (in column 1, line 28, it is stated that the device is to be made of rubber) having a longitudinally extending opening (16) and a hollow interior portion (see Fig. 3). However Hulsman fails to include a thumb-receiving member that is connected to the body portion positioned opposite the fingers receiving member. He also fails to show wherein the thumb-receiving member defines a thumb-receiving loop extending laterally connected to the body portion. But, Cutting teaches the use of a thumb-

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receiving member (16,18) in a golf grip guide. Cutting also indicates the thumb-receiving member (16,18) positioned opposite a finger-receiving (20) element.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a thumb receiving member as taught by Cutting in the Hulsman's device in order to maintain a firmer grip on the club and to prevent the golfers hands from slipping and to keep the club shaft from turning in the hands during the golfer's swing as stated in column 1, lines 28-31 of the Jacques' reference.

- **With respect to claims 2 and 12**, Hulsman discloses a body portion that is flexible (in column 1, line 28, it is stated that the device is to be made of rubber).
- **With respect to claims 3 and 13**, Hulsman discloses wherein the body portion has a generally cylindrical shape (column 1, line 51).
- **With respect to claim 4**, Hulsman discloses wherein the body portion includes a longitudinally extending opening (16 and see column 1, line 53).
- **With respect to claims 5 and 14**, Hulsman discloses wherein the fingers receiving member is adapted to extend over and secure two fingers of a user (see 18 and Fig. 5).
- **With respect to claims 6 and 15**, Hulsman discloses wherein the two fingers are adjacent (for example when seeing Fig. 5, the middle finger and the index fingers of the right hand are shown as being adjacent to each other).
- **With respect to claims 7 and 16**, Hulsman discloses wherein the two fingers are not adjacent (for example when seeing Fig. 5, the index finger of the right

hand and the index finger of the left hand are shown as being not adjacent to each other).


- **With respect to claim 8**, Hulsman discloses wherein the fingers receiving member defines a fingers receiving loop extending longitudinally along the body portion (the combination of guard 18 and the side elements and the area of the depressions 22 as shown on Fig. 3 provide a fingers receiving loop).
- **With respect to claim 10**, Hulsman discloses wherein the body portion that is adapted to be secured to the sporting element is a golf club (column 1, line 48).
- **With respect to claims 17-19**, during normal use and operation of the Hulsman device as modified above, the method steps as claimed would inherently be performed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vidovich Greg can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nini F. Legesse
07/12/04